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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,410

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David Paul Brisco

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Conley Rose, P.C

P.O. Box 3267

Houston, TX 77253-3267

EXAMINER

BOMAR, THOMAS S

ART UNIT

PAPER NUMBER

3676

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,410	<b>Applicant(s)</b> BRISCO ET AL.	
	<b>Examiner</b> Shane Bomar	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 21-34 and 45-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19 and 35-43 is/are rejected.
- 7) ☒ Claim(s) 10, 20 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species I in the reply filed on March 28, 2008 is acknowledged. The traversal is on the ground(s) that the requirement was made based on PCT Rules. This is not found persuasive because the current application is a National Stage entry of PCT/US04/08073, thus the US Application is bound by PCT rules in terms of restriction requirements. See MPEP 1893.03(d).

The requirement is still deemed proper and is therefore made FINAL. Also, the Applicant alleges that certain new claims correspond to elected Species I. This appears to be improper as every new claim corresponds to limitations only found in non-elected Species II (e.g., expandable tubulars, placing the expandable tubular in tension, etc.), and none of the limitations of the elected species can be found in any of these claims, such as a third tubular member moveable relative to a first and second tubular member. Therefore, based upon the Applications election of Species I, claims 1-20 and 35-44 are deemed as readable thereon and are thus currently pending and hereafter examined.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or

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provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/455,718, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application only provides support for a first tubular member that is moveable relative to a second tubular member, there being no third tubular member as currently claimed.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 76. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities: there are numerous blanks throughout the specification that must be filled in prior to allowance. The Applicant is also respectfully requested to update the copending application data throughout to indicate whether the applications have either become patented or abandoned.

Appropriate correction is required.

***Claim Objections***

5. Claim 35 is objected to because of the following informalities: the letter --A-- should be added to the beginning of the preamble. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8, 9, 18, 19, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 8, 18, and 42, it is unclear how the first tubular member can be disconnected from the second tubular and then reconnected to itself. Perhaps the Applicant meant to refer to the third tubular member. Claims 9, 19, and 43 depend from these indefinite claims and are also considered to be indefinite.

***Claim Clarification***

8. Since the claim language does not directly correspond to the language used in the description, it was difficult for the Examiner to ascertain that which the Applicant claims as the first, second, and third tubular members. Upon careful review of the drawings and description, the Examiner comes to the following conclusion: the third tubular member is embodied by at least elements 56, 22, 24, and 102; the first tubular member is embodied by at least elements 72, 88, and 34; and the second tubular member is embodied by at least elements 114, 120, 26, and 28, wherein the first and second tubular members are connected by fasteners 136. If this interpretation of the Applicant's invention is improper, then the Applicant is respectfully requested to provide clarification and to better relate the claim limitations to the detailed description of the invention.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-9, 11-19, and 35-43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,787,981 to Taylor.

Regarding claims 1, 11, and 35, Taylor discloses a system, method, and tubular apparatus comprising: lowering a first tubular member 42 into a well bore; connecting a second tubular member 26 to the first tubular member by way of outer body 3; connecting a third tubular

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member 31 to the first tubular member (Fig. 3); and moving the third tubular member relative to the first and second tubular members to disconnect the third tubular member from the first tubular member and connect the third tubular member to the second tubular member (Figs. 3-5; col. 4, lines 15-64).

Regarding claims 2, 12, and 36, the third tubular member moves relative to the first and second tubular members in response to at least one of the first and second tubular members encountering a resistance in the well bore (col. 4, lines 24-27).

Regarding claims 3, 6, 13, 16, 37, and 40, the third tubular member moves axially relative to the first and second tubular members (Figs. 3-5).

Regarding claims 4, 5, 14, 15, 38, and 39, there is a means for applying a torque to the third tubular member after the step of moving, where the torque is transferred from the third tubular member to the second third tubular member to enable the resistance to be overcome (col. 4, line 65 through col. 5, line 14; col. 6, lines 6-13).

Regarding claims 7, 17, and 41, further comprising moving the third tubular member relative to the first and second tubular members in a direction opposite the one direction to disconnect from the second tubular member and reconnect with the first tubular member (col. 5, lines 26-45).

Regarding claims 8, 18, and 42 (all as best understood), the same means for applying a torque to the third tubular member after the step of moving will supply torque when the third member is again attached to the first tubular member.

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Regarding claims 9, 19, and 43, a fourth tubular member may be threadedly attached to the bottom of member 19 and torque is then transferred to back-off the threaded connection (col. 6, lines 14-20).

***Conclusion***

11. The prior art made of record on form 892 and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is (571)272-7026. The examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shane Bomar/  
Examiner, Art Unit 3676